

ATTACHMENT A

Remarks

By this Amendment, independent claims 28 and 32 have been further amended to better avoid the art rejection. In addition, dependent claim 31 has been amended to correct a minor antecedent basis problem and dependent claims 49-55 have been amended to more definitely claim the additional limitations. In addition, these and other dependent claims have been amended consistent with the changes made to the independent claims from which they depend. It is submitted that the present application is in condition for allowance for the following reasons.

In the *Claims Objections* section, dependent claims 42-47 (so called “Beauregard” claims), were objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. In particular, the examiner noted that the objected to claims were directed to a computer program product or computer readable medium, whereas claim 32 from which they each depend was directed to a method. However, as set forth in MPEP § 608.01(n) which discusses what is or is not a proper dependent claim, it is stated:

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim. [emphasis added]

...
Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were presented as one independent claim. [emphasis added]

The fact that a dependent claim which is otherwise proper might relate to a separate invention which would require a separate search or be

separately classified from the claim on which it depends would not render it an improper dependent claim,

The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper. [emphasis added]

It is thus apparent from the MPEP that the fact that claims 42-47 are directed to an apparatus and that claim 32 is directed to a method is not controlling. Instead, if claims 42-47 are treated as independent claims as required, such claims are not improper but instead are exactly of the type accepted by the Federal Circuit in the case of *In re Beauregard*. In addition, it is apparent that claims 42-47 include every limitation of claim 32 from which they each depend, and that claims 42-47 meet the noted infringement test. As the above does not appear to be in dispute (as the examiner did not raise any of these issues) and are the factors to be determined to see if a dependent claim is proper, it is submitted that claims 42-47 are proper and the rejection for improper dependency should be withdrawn.

In the *Claim Rejections - 35 USC § 112* section of the outstanding Office Action, all of the pending claims were variously rejected for being indefinite. For convenience, the four particularly noted reasons for these rejections will be discussed separately hereafter.

1) In the § 112 rejection, independent claim 28 and the claims dependent therefrom were alleged by the examiner to be “merely a series of action that the apparatus can be configured or programmed to carry out”. Why this language of the claim, which has present for numerous previous Office Actions, is now objected to for this reason is not understood. The claim language positively requires a “computer means” (an apparatus) which is “configured or programmed” (a positive recitation) to perform certain functions.

Thus, rather than being some “can be” limitation as alleged, the recited language is positive in what is required and in fact such a (computer) “means plus function” language is explicitly acknowledged as acceptable by § 112, 6th paragraph.

2) In the rejection of dependent claims 29-31 and 49-55, the examiner objected to the use of the term “operable”, alleged to be a “can be” recitation as well. While this language does not seem the same as “can be” and evidently was not taken as such in any of the numerous previous examiner actions, which was the specific objection, the language “operable” has been replaced with “further configured or programmed” to mimic the same language of the independent claim and continue the “means plus function” language recitations thereof.

3) Claim 31 was also objected to for the use of “all approval criteria”. The continued use of this terminology, previously replaced in the independent claim, was thus an oversight by applicant and has now been corrected.

4) Similar to the claims “objection” discussed above, dependent claims 42-47 were rejected under § 112 as well for being “directed to different statutory than claim 32”. As noted in the above discussion of the similar § 1.75(c) rejection, such is not a ground for rejection of a dependent claim without a further analysis as set forth in MPEP § 608.01(n); and claims 42-47 meet the tests for being proper dependent claims as set forth therein.

Therefore, for all of the foregoing reasons, it is submitted that the rejections under § 112 should now be withdrawn.

In the *Claim Rejections - 35 USC § 102 and § 103* sections, independent claims 28 and 32 were again rejected under 35 USC § 102 as being anticipated by the Tengel

patent; while all of the claims dependent therefrom were either similarly rejected over the Tengel patent or rejected as being obvious over the Tengel patent in combination with the Lent patent or the Hartman patent. However, for the following reasons, it is submitted that both independent claims are allowable over the Tengel patent.

In the initial *Response to Amendment/Arguments* section, the examiner noted that the Tengel patent met the newly added claim limitation “to request without duplicative queries” since the Tengel patent loan form “is absent duplicated requests for information”. While this statement is probably true as the loan form presented by the Tengel patent is merely a loan form from a single lender (which the lender would presumably draft to avoid duplicated requests), such a presentation is irrelevant to what is intended and now even more particularly claimed in both independent claims.

As noted previously, the present invention includes a superset of the approval criteria of a plurality of application recipients (e.g., lenders). This superset is a union of the respective sets of the plurality of lenders, and as such the superset does include at least one repeated criterion as a result of a same criterion being part of the approval criteria of two or more of the plurality of lenders. The presence of a repeated criterion is an unavoidable consequence of the method of the present invention where the criteria of two or more of the plurality of lenders is used to create an application, so that the application can be evaluated according to the criterion of each of the plurality of lenders - and the application is not just one application of a single lender to be evaluated by that lender as in the Tengel patent. This superset is thus now positively claimed as containing such a “repeated criterion” to more clearly differentiate from the Tengel

patent which does not have such a union of respective sets of criteria, and which does not generate queries from such a superset but only from the form of a selected lender.

It will be noted that the independent claims also now further recite that only a single query is presented “for the same criteria of the two or more” lenders contained in the superset by which the application is generated for the two or more lenders, so that the associated queries “are free of repeated queries”. As the Tengel patent only presents a single application from a single lender, the Tengel patent does not disclose or make obvious that the application could have repeated criteria. In addition, even if the Tengel patent were somehow considered to present two application forms from two lenders to meet that limitation of the present invention and thus with the two lender's forms then having a superset with repeated criteria, there would be no way that the system of the Tengel patent could delete the repeated queries from the two forms which would be presented – and to do so would leave one of the forms of one of the lenders incomplete and hence useless to that lender.

Therefore, for all of the foregoing reasons, it is submitted that amended independent claims 28 and 32 are neither disclosed nor made obvious by the Tengel patent so that these claims are now allowable. For these same reasons, it is submitted that the remaining claims which are all dependent from the independent claims are likewise allowable.

For all of the foregoing reasons, it is submitted that the present application is in condition for allowance and such action is solicited.